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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,847	07/10/2003	Hazel Judith Bardsley	GJE-6757C1	7988

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EXAMINER	
SOROUSH, LAYLA	
ART UNIT	PAPER NUMBER
1617	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/617,847	BARDSLEY ET AL.	
	Examiner	Art Unit	
	Layla Soroush	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The response filed January 16, 2007 presents remarks and arguments submitted to the office action mailed July 13, 2006 is acknowledged.

Applicant's arguments over the 35 U.S.C. 103 (a) rejection of claims 1-4 and 6-18 over Ninomiya et al. (US Pat. No. 4,695,568 –IDS), in view of Davies et al. (US Pat. No. 6,008227) is persuasive. Therefore, the rejection is withdrawn.

Applicant's arguments over the Obvious Double Patenting rejection over co-pending Application No. 10/525532 is not persuasive. The ODP rejection made will be withdrawn once the Terminal Disclaimer is filed. However, the rejection is maintained for the reasons of record.

Applicant's arguments over the 35 U.S.C. 101 rejection of claims 5-11 over co-pending Application No. 10/519594 is not persuasive. Thus, the rejection is maintained for the reasons of record.

In view of applicant's arguments to the claims, the following new rejections are made:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ninomiya et al. (US Pat. No. 4,695,568 –IDS), in view of McInally et al. (PCT/SE98/00641 English equivalent US Pat. No. 6303613) and Kelley et al. (US PAT No. 5708033).

Ninomiya et al. teaches a 4-(2-Flourophenyl)-6-methyl-2-(1-piperazinyl)thieno[2,3-D]pyrimidine monohydrate hydrochloride in treatment of various depressions (see abstract; column 4, lines 9-11).

Ninomiya et al. fails to teach the treatment of pain, irritable bowel syndrome, and fibromyalgia.

McInally et al. teaches especially preferred embodiments are where the compound of formula (I) is a thieno[2,3-d]pyrimidine or a thieno[3,2-d]pyrimidine (columsn 3, line 13-15). The compounds "are indicated for use in the treatment of inflammatory conditions in mammals, including man. Conditions that may be specifically mentioned" are inclusive of osteoarthritis, rheumatoid arthritis, rheumatoid spondylitis, gouty arthritis and other arthritic conditions, inflamed joints, pain, acute or persistent inflammatory or neuropathic pain or pain of a central origin (nociceptive or neuropathic), and conditions of the gastrointestinal tract such as irritable bowel syndrome (column 8, line 23-25, 38, and 40-45).

Kelley et al. teaches the equivalence of inflammatory conditions, arthritis or pain, e.g. rheumatoid arthritis or spondylitis, fibromyalgia.

Therefore, it would have been obvious to one of ordinary skill in the art to use the identical compound in treating pain, irritable bowel syndrome and fibromyalgia. The motivation to use 4-(2-Flourophenyl)-6-methyl-2-(1-piperazinyl)thieno[2,3-D]pyrimidine to treat pain, irritable bowel syndrome and fibromyalgia is because the teachings in McInally et al. that thieno[2,3-d]pyrimidine compounds "are indicated for use in the treatment of inflammatory conditions in mammals, including man. Conditions that may be specifically mentioned" are inclusive of osteoarthritis, rheumatoid arthritis, rheumatoid spondylitis, gouty arthritis and other arthritic conditions, inflamed joints, pain, acute or persistent inflammatory or neuropathic pain or pain of a central origin (nociceptive or neuropathic) and conditions of the gastrointestinal tract such as irritable bowel syndrome (column 8, line 23-25, 38, and 40-45). The skilled artisan would have reasonable expectation of successfully treating pain, irritable bowel syndrome and fibromyalgia using the antidepressant drug 4-(2-Flourophenyl)-6-methyl-2-(1-piperazinyl)thieno[2,3-D]pyrimidine.

Additionally, because the reference teaches the genus irritable bowel syndrome, the species diarrhea-predominant irritable bowel syndrome, alternating constipation/diarrhea irritable bowel syndrome, and constipation-predominant irritable bowel syndrome of claims 8, 10, and 11 are rendered obvious by the teachings of the prior art. The reference teaches patients in general, therefore, the limitation of claim 9, "wherein the patient is female" is rendered obvious by the prior art.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 5-11 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7 of copending Application No.10519594. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 30, 31, and 35 of co-pending application no. 10/525532. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention of the copending application is drawn to a method for the treatment of a condition selected from the group consisting of fibromyalgia; Parkinson's disease; stroke; and schizophrenia; wherein the treatment comprises administering, to an individual in need of such treatment, (4-(2-Flourophenyl)-6-methyl-2-(1-piperazinyl)thieno[2,3-D]pyrimidine or a salt thereof whereas the invention herein is drawn to a a method for the treatment of fibromyalgia which comprises administering to a patient an effective amount of 4-(2-Flourophenyl)-6-methyl-2-(1-piperazinyl)thieno[2,3-D]pyrimidine.

The invention is rendered obvious because the claims of the copending application teach a genus of diseases treated by the same composition. The copending application specifically recites the treatment of the condition fibromyalgia.

Response to Arguments

Applicant's arguments January 16, 2007 have been fully considered but they are not persuasive for the reasons set forth below.

Applicant's arguments regarding the Ninomiya et al. reference provides no basis for concluding 4-(2-Flourophenyl)-6-methyl-2-(1-piperazinyl)thieno[2,3-D]pyrimidine monohydrate hydrochloride is an effective anti-depressant is not persuasive. In particular, claims 17 and 18 are drawn to the pharmaceutical for improving the

depressive conditions and/or dysfunction of the brain. However the arguments with respect to the Davies et al. (US Pat. No. 6,008227) have been considered and are persuasive. In view of the new ground(s) of rejection the applicant's arguments are moot.

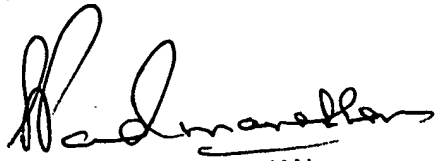
Conclusion

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Soroush whose telephone number is (571)272-5008. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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